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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,281	10/03/2001	Christopher A. Atwood	16159/027001 P6420	9102
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OSHA & MAY L.L.P./SUN 1221 MCKINNEY, SUITE 2800 HOUSTON, TX 77010			VO, TED T	
			ART UNIT	PAPER NUMBER

2192

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/970,281

Applicant(s)

ATWOOD ET AL.

Examiner

Ted T. Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to the amendment filed on 11/03/2004 responsive to the Office action dated, 08/04/04.

- Claims 27-29 are canceled. The rejection of claims 27-29 under 35 U.S.C 101 thus is withdrawn.

Within this detailed action,

- Claims 1-26, 30 stand finally rejected under 35 U.S.C. 102(a) as being anticipated by Wilson et al., "The whiteboard: Tracking usability issues: to bug or not to bug?".

- Claims 1-26, 30 would be required in the next amendment that when a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation (See 37 CFR 1.75 and MPEP 608.01(i)-(p)).

- Claims 1-26, 30 are pending in this application.

### *Response to Arguments*

2. Applicants' arguments in the remarks (page 6-8) based on the filing DECLARATION PURSUANT TO 37 CFR :1.131 have been fully considered, where Applicants alleged that the declaration with its attachment (pages 1-9) is given as evidenced under 37 C.F.R. 1.131 and is constructively reduced to practice with due diligence (Applicant's Remarks, page 7, within paragraph below "Rejection(s) under U.S.C. § 102").

Examiner respectfully disagrees:

MPEP - 37 C.F.R. 1.131(b)

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must

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accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

**MPEP 715.07(a)**

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958).

Under 35 U.S.C 112, First paragraph, to prevent adding New Matter, it requires that Applicants of an application were in possession of the claimed invention at the time the application was filed. See In re Daniels, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Therefore, in the possession of the claimed invention prior a reference under MPEP - 37 C.F.R. 1.131, the conception of the invention prior to the effective date must be clearly established. The only evidence given by Applicants in this case is the statement (Declaration, page 1, item 2), quote "*conceived the claimed invention prior at least February 2000, as evidenced by the date of the first written description listed in the Internal Disclosure (see attached) for the Sun reference number P6420 entitled "Market Development Engineering – Bug council Process" and email on May 7, 2001 in which we were listed as inventors*" unquote. This Applicants' statement including the exhibit ("see attached") does not meet the diligence under 37 C.F.R. 1.131 (b) and MPEP 715.07(a). Furthermore, the attachment/exhibit (pages 2-8) submitted by Applicants within Declaration does not show any conception, weight, or original drawings/records/ photocopies.

Because the Applicants' attachment/exhibit submitted as evidence filed under 37 CFR 1.131 does not meet due diligence, but a mere allegation, the filing under 37 CFR 1.131 does not constructively reduce the application to practice before its effective filing date.

The rejection thus will be maintained.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claim 1-26, 30 are rejected under 35 U.S.C. 102(a) as being anticipated by Wilson et al., "The whiteboard: Tracking usability issues: to bug or not to bug?" 6-2001.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Wilson discusses tracking bugs. The discussion discloses limitation,

*"A method of rating a bug, comprising: reporting the bug to a business entity by an interested party; entering information regarding the bug into a database (See page 17, left column, "Chauncey's Rejoinder", first paragraph, tracking usability bugs in a corporate bug data base; page 19, left column, the second indentation \*, "add the bug to the database");*

*assigning a priority number for the bug (See page 18, table in left column, "Severity Rating");*

*calculating a sigma number for the bug using the priority number (Sigma number is interpreted in light of the specification: the discussions: page 17, Chauncey's Rejoinder: "create a usability severity scale that parallels the severity scale of other bugs", right column, the second and fourth "\*" indentions, page 18; left column, the third, fourth, and seventh "\*" indentions, have means for calculation);*

*evaluating the bug to be fixed using the sigma number (See page 18, See "How Do You Determine the Severity of Usability Bugs?"); and*

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*escalating the bug*" (See page 19, left column, first "\*" indentation, "Create bug reports for all details", second "\*" indentation, "added to the bug report", "write summaries and severity ratings in the report"; see "How Do You Determine the Severity of Usability Bugs?").

As per Claim 2: Wilson discloses, *"The method of claim 1, further comprising: fixing the bug; relaying information concerning a fixed bug to the interested party; and obtaining feedback regarding the fixed bug from the interested party"* (See page 18, left column, eighth "\*" indentation, "bug report...").

As per Claim 3: Wilson discloses, *"The method of claim 1, further comprising: assigning the priority number automatically"* (See Table in page 18).

As per Claim 4: Wilson discloses, *"The method of claim 1, further comprising: calculating the sigma number automatically"* (The discussions: page 17, Chauncey's Rejoinder: "create a usability severity scale that parallels the severity scale of other bugs", right column, the second and fourth "\*" indentions, page 18; left column, the third, fourth, and seventh "\*" indentions, have means for calculation).

As per Claim 5: Wilson discloses, *"The method of claim 1, further comprising: performing queries on the database to gather information on the bug"* (See page 17, left column, "Chauncey's Rejoinder", first paragraph, "tracking usability bugs in a corporate bug data base...").

As per Claim 6: Wilson discloses, *"The method of claim 1, further comprising: reporting progress and results of the bug evaluation"* (See page 17, right column, fourth "\*" indentation).

As per Claim 7: Wilson discloses, *"The method of claim 6, wherein the reporting is displayed using a graphical user interface"* (See page 17, right column, fourth "\*" indentation).

As per Claim 8: Wilson discloses, *"The method of claim 1, further comprising: initiating alerts at certain threshold sigma numbers"* (Referring to "severity rating scale". For example "1-Sever" in the table of page 18 has means of a threshold sigma number).

As per Claim 9: Wilson discloses, *"The method of claim 1, wherein the information regarding the bug is entered using a graphical user interface"* because the bug tracking done with computer subject mater. For example, seen in the terms "create graphs", "database", "log", etc.).

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As per Claim 10: Wilson discloses, "*The method of claim 1, wherein evaluating the bug relies upon a cost-benefit analysis*" (See page 15, "communicate usability problems through reports...", see page 18, see "How Do You Determine the Severity of Usability Bugs?").

As per Claim 11: Wilson discloses, "*The method of claim 1, wherein the sigma number dynamically reflects the impact of the bug on the business entity over time*" in the term: severity scale, and particularly, insisted in all "\*" indentions in pages 16-19.

As per Claim 12: Wilson discloses, "*The method of claim 1, wherein the information entered into the database comprises data associated with the bug, data associated with a reporting vendor, and data related to a software application with the bug*" (See page 17, left column, "Chauncey's Rejoinder", first paragraph, tracking usability bugs in a corporate bug data base; page 19, left column, the second indentation \*, "add the bug to the database", where "*reporting vendor, and data related to a software application*" is inherent in "bugs").

As per Claim 13: Wilson discloses, "*The method of claim 1, wherein escalating the bug comprises ranking the bug and setting an order of significance*" (The table in page 18 remains has means of "ranking the bug and setting an order of significance").

As per Claim 14: Wilson discloses, "*A method of rating a bug, comprising:*

*reporting the bug to a business entity by an interested party; entering information regarding the bug into a database* (See page 17, left column, "Chauncey's Rejoinder", first paragraph, tracking usability bugs in a corporate bug data base; page 19, left column, the second indentation \*, "add the bug to the database");

*assigning a priority number for the bug* (See page 18, table in left column, "Severity Rating");

*calculating a sigma number for the bug using the priority number* (Sigma number is interpreted in light of the specification: the discussions: page 17, Chauncey's Rejoinder: "create a usability severity scale that parallels the severity scale of other bugs", right column, the second and fourth "\*" indentions, page 18; left column, the third, fourth, and seventh "\*" indentions, have means for calculation);

*evaluating the bug to be fixed using the sigma number; escalating the bug;* (See page 18, See "How Do You Determine the Severity of Usability Bugs?", see page 19, left column, first "\*" indentation,

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"Create bug reports for all details", second "\*" indentation, "added to the bug report", "write summaries and severity ratings in the report").

*fixing the bug; relaying information concerning a fixed bug to the interested party; obtaining feedback regarding the fixed bug from the interested party* (See page 18, left column, eighth "\*" indentation, "bug report...");

*assigning the priority number automatically* (See Table in page 18);

*calculating the sigma number automatically* (The discussions: page 17, Chauncey's Rejoinder: "create a usability severity scale that parallels the severity scale of other bugs", right column, the second and fourth "\*" indentions, page 18; left column, the third, fourth, and seventh "\*" indentions, have means for calculation);

*performing queries on the database to gather information on the bug* (See page 17, left column, "Chauncey's Rejoinder", first paragraph, "tracking usability bugs in a corporate bug data base...");

*reporting progress and results of the bug evaluation; and initiating alerts at certain threshold sigma numbers* (See page 17, right column, fourth "\*" indentation).

As per Claim 15: Wilson discloses,

*"A bug council rating apparatus, comprising:*

*a database to store the information entered using a graphical user interface;*

*a priority number module configured to generate a priority number; and a sigma number module configured to generate a sigma number."* (See rationale in Claim 1 above).

As per Claim 16: Wilson discloses, *"The apparatus of claim 15, further comprising: a monitoring module to monitor the value of the sigma number for a bug and initiating alerts at certain threshold sigma numbers; and a reporting module to produce reports and track the progress of the bug"* (See rationale in Claim 8 and Claim 6 above).

As per Claim 17: Wilson discloses, *"The apparatus of claim 15, wherein evaluating the bug relies upon a cost-benefit analysis."* (See rationale in Claim 10 above).

As per Claim 18: Wilson discloses, *"The apparatus of claim 15, wherein the priority number is based on information stored in the database"* (See rationale in Claim 5 above).



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As per Claim 19: Wilson discloses, "*The apparatus of claim 15, wherein the sigma number is based on the priority number over a period of time.*" (See rationale in Claim 11 above).

As per Claim 20: Wilson discloses, "*The apparatus of claim 15, wherein the information entered into the database comprises data associated with the bug, data associated with a reporting vendor, and data related to a software application with the bug.*" (See rationale in Claim 12 above).

As per Claim 21: Wilson discloses, "*A bug council rating apparatus, comprising:*

*a database to store the information entered using a graphical user interface* (See page 17, left column, "Chauncey's Rejoinder", first paragraph, tracking usability bugs in a corporate bug data base; page 19, left column, the second indentation \*, "add the bug to the database");

*a priority number module generating a priority number based on information stored in the database* (See page 18, table in left column, "Severity Rating");

*a sigma number module generating a sigma number based on the priority number over a period of time* (Sigma number is interpreted in light of the specification: the discussions: page 17, Chauncey's Rejoinder: "create a usability severity scale that parallels the severity scale of other bugs", right column, the second and fourth '\*' indentions, page 18; left column, the third, fourth, and seventh '\*' indentions, have means for calculation);

*a monitoring module to monitor the value of the sigma number for a bug and initiating alerts at certain threshold sigma numbers* (severity rating scale, for example "1-Sever" in the table of page 18 has means of a threshold sigma number); *and*

*a reporting module to produce reports and track the progress of the bug* (See page 17, right column, fourth '\*' indentation).

As per Claim 22: Claim 22 is claiming a system that has the limitation corresponding to functionality performed by the method of Claim 1. Claim 22 is rejected in the same reason set forth in connecting to the rejection of Claim 1.

As per Claim 23: Claim 23 is claiming a system that has the limitation corresponding to functionality performed by the method of Claim 10. Claim 23 is rejected in the same reason set forth in connecting to the rejection of Claim 10.

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As per Claim 24: Claim 24 is claiming a system that has the limitation corresponding to functionality performed by the method of Claim 11. Claim 24 is rejected in the same reason set forth in connecting to the rejection of Claim 11.

As per Claim 25: Claim 25 is claiming a system that has the limitation corresponding to functionality performed by the method of Claim 12. Claim 25 is rejected in the same reason set forth in connecting to the rejection of Claim 12.

As per Claim 26: Claim 26 is claiming a system that has the limitation corresponding to functionality performed by the method of Claim 13. Claim 26 is rejected in the same reason set forth in connecting to the rejection of Claim 13.

As per Claim 30: Claim 30 is claiming an apparatus that has the limitation corresponding to functionality performed by the method of Claim 1. Claim 30 is rejected in the same reason set forth in connecting to the rejection of Claim 1.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3694. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ted T. Vo  
Primary Examiner  
Art Unit 2192  
March 29, 2005